

REMARKS/ARGUMENTS

Status of the Claims

Upon entry of the present amendment, claims 32-81 are pending. Claim 64 has been amended for proper antecedent basis.

Obviousness-Type Double Patenting Rejections

U.S. Patent Nos. 5,719,060; 5,894,063; 6,027,942 and 6,734,022

The Examiner has rejected claims 32-62 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-20, 1-47, 1-54, and 1-20 of U.S. Patent Nos. 5,719,060; 5,894,063; 6,027,942; and 6,734,022, respectively. Applicants do not agree with the Examiner. However, in the interest of furthering prosecution, Applicants submit with this response Terminal Disclaimers for the present application in view of U.S. Patent Nos. 5,719,060; 5,894,063; 6,027,942; and 6,734,022.

U.S. Patent Nos. 6,020,208; 6,124,137; and 6,528,320

The Examiner has rejected claims 49-81 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-54, 1-61 and 1-45 of U.S. Patent No. 6,020,208; 6,124,137; and 6,528,320, respectively. Applicants do not agree with the Examiner. However, in the interest of furthering prosecution, Applicants submit with this response Terminal Disclaimers for the present application in view of U.S. Patent Nos. 6,020,208; 6,124,137; and 6,528,320.

U.S. Patent Nos. 6,225,047; 6,811,969 and 6,881,586

The Examiner has rejected method claims 49-62 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims in U.S. Patent Nos. 6,225,047; 6,811,969 and 6,881,586. This rejection is respectfully traversed because the claims of the '047 patent, the '969 patent, and the '586 patent do not teach or suggest

in any way a method using a probe comprising **both** energy absorbing molecules and an affinity reagent capable of binding an analyte, which are both immobilized by chemical bonding to the sample presenting surface. The Examiner is respectfully reminded that in making an obviousness-type double patenting rejection, the Examiner is to analyze the differences between the presently *claimed* invention and the *claims* of the cited patent or patent publication. When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. M.P.E.P. § 804(II)(B)(1). Because the claims in the '047 patent, the '969 patent, and the '586 patents do not provide any indication of a method using a probe comprising **both** energy absorbing molecules and an affinity reagent capable of binding an analyte, which are both immobilized by chemical bonding to the sample presenting surface, the claims of these patents do not render the presently claimed methods obvious. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Provisional Obviousness-Type Double Patenting Rejections

U.S. Patent Application Nos. 10/440,041, 10/626,301 and 10/626,493

The Examiner has provisionally rejected method claims 49-62 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-18, 1-35 and 1-53 of co-pending Application Nos. 10/440,041¹; 10/626,301; and 10/626,493, respectively. These provisional obviousness-type double patenting rejections are traversed for the following reasons:

These are provisional obviousness-type double patenting rejections. The Examiner is respectfully reminded that if a "provisional" double patenting rejection in one application is the only rejection remaining in that application, the Examiner should then

¹ It is noted that Application Number 10/440,041 was published as U.S. Patent Publication No. 2004/0230821. The '041 application has been improperly cited in the present rejection because it does not share either a common inventor or a common assignee. Because the '041 application is completely unrelated to the present application, the Examiner is respectfully requested to withdraw the present rejection. For the Examiner's convenience, the front page of U.S. Patent Publication No. 2004/0230821 is submitted with this response as Exhibit A.

Appl. No. 10/728,442
Amdt. dated October 31, 2005
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 1743

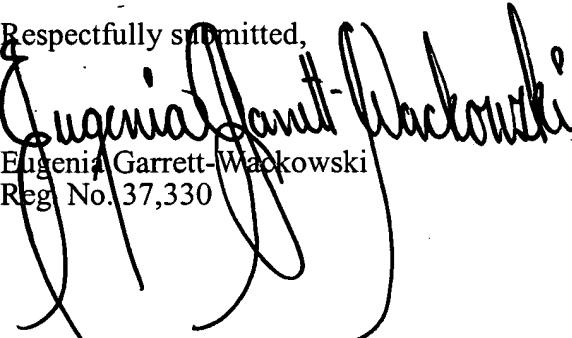
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withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application into a double patenting rejection at the time the one application issues as a patent. M.P.E.P. § 804(I)(B). In accordance with M.P.E.P. § 804(I)(B), the Examiner is respectfully requested to withdraw these provisional obvious-ness-type double patenting rejections.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

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Attachments
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